



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/339826
Filing Date: 6-25-99
Appellant(s): Natsuhara et al

Arthur Steiner
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 3-12-01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 1755

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 1755

5,540,884	Chiao	7-1996
5,165,983	Sugiura et al	11-1992
4,963,701	Yasumoto et al	10-1990
5,773,377	Harris et al	6-1998
JP08157265	Monma et al	6-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harris et al (US 5,424,261), Chiao, Yasumoto et al, Sugiura et al and JP08157265 (Monma et al), each taken alone.

Harris et al teach AlN sintered bodies including sintering aids to be used in electronic substrates which are sintered under weight such as setters, see column 4, lines 39-42 and examples 3-22.

Chiao teaches AlN sintered bodies including sintering aids and having high thermal conductivity and low camber (warping), see Table V.

Yasumoto et al teach AlN circuit boards including sintering aids and no warping, see column 3, lines 35-50.

Sugiura et al teach AlN bodies including sintering aids that are sintered with a support base, see column 2, lines 40-45 and examples.

The Japanese Document JP08157265 teach AlN substrates having an excellent surface smoothness of less than 10 microns.

Art Unit: 1755

Claims 1-3 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harris et al (US 5,773,377).

Harris et al teach low camber AlN sintered bodies including sintering aids.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

(11) Response to Argument

Appellants argue that the data of table 2 of the instant disclosure was not considered. The data of table 2 of the specification was considered however is not considered to represent the AlN bodies of the prior art. Clearly the comparative examples 22-25, 28 and 29, that do not use setters, cannot represent Harris et al '261 and Sugiura et al which both use support or setters. Furthermore, the other references control the warping of the substrates by controlling sintering and/or atmospheres which are not exemplified by the comparative examples in the instant disclosure.

It is further argued by appellants that no basis has been supplied that the aluminum nitride bodies inherently possess the claimed characteristics. It is the examiner's position that all the prior art references teach high thermal conductivity AlN substrates where any warping

Art Unit: 1755

is controlled or held to a minimum. It appears if the sintering aids are insufficiently distributed in the sintered body warping (or distortion occurs), see page 3 lines 10-13 of the instant disclosure. Appellants have not shown by way of tangible evidence that the distribution of sintering aids as set forth in claim 1 by the claimed formula distinguish from the prior art references.

Furthermore any evidence in the disclosure does not represent the processes of the references.

Yasumoto et al recognizes warping must be controlled, column 3, lines 44-45.

In respect to Chiao and Sugiura et al appellants argue warping is controlled by different process steps. "The patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Again applicants have not shown that the claimed formula is unique to the instant invention.

In reference to the Harris patents applicants claims are silent as to any minimum amount of warping as well no evidence has been submitted showing the AlN articles produced by Harris are outside the claimed characteristics.

Art Unit: 1755


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


KARL GROUP
PRIMARY EXAMINER
GROUP 1755

keg
April 19, 2001

600 13th Street, NW.
Washington, DC 20005-3096


GABRIELLE BROUILLETTE
SUPERVISORY PATENT EXAMINER /CONFREC
TECHNOLOGY CENTER 1700


Conferee